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PATENT DEPT., BLDG. 11-7  
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## FAX TRANSMITTAL

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JUL 13 2005

Date: July 13, 2005

No. of Pages: 23 (Including this page)

To: Central Facsimile Number From: Sherry Thompson  
Of: USPTO Fax: (740) 321-8024  
Fax: (703) 872-9306 Phone: (740) 321-7361

SUBJECT: Petition to Revive Abandoned Application

Serial No.: U.S. Patent Application 10/664,552, filed September 18, 2003

I hereby certify that a Petition to Revive Abandoned Application for the above noted case is being transmitted to the Central Facsimile Number, at the U.S. Patent and Trademark Office (Fax No. (703) 872-9306) on July 13, 2005.

July 13, 2005

(Date of Deposit)

Sherry Thompson

(Name of Depositor)

Sherry Thompson

(Signature)

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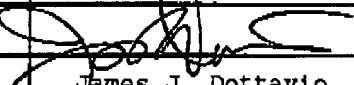
# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/664,552		
Filing Date	September 18, 2003		
First Named Inventor	Elliott		
Art Unit	3,635		
Examiner Name	Chapman		
Total Number of Pages in This Submission	822	Attorney Docket Number	25244A

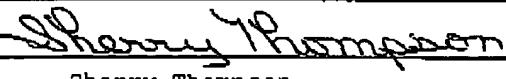
ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers  <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Owens Corning Science & Technology Center		
Signature			
Printed name	James J. Dottavio		
Date	7-12-05	Reg. No.	40,360

## CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	Sherry Thompson	Date	7/13/05

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: )  
Bert W. Elliott )  
Serial No.: 10/664,552 )  
Filed: September 18, 2003 )  
For: Laminated Starter Shingle For A )  
Roof Covering )

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JUL 13 2005

Group Art Unit: 3635  
Examiner: Jeanette E. Chapman

Petition to Revive Abandoned Application  
Under 37 C.F.R. § 1.181

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants submit this petition under 37 C.F.R. § 1.181 to withdraw holding of abandonment in the above captioned application.

A copy of the Notice of Abandonment is enclosed as Exhibit A. This Notice is dated June 30, 2005, and this Petition is promptly and diligently filed within one month of the abandonment.

Applicant requests that the holding of abandonment in the above application be withdrawn. The Notice of Abandonment indicates Applicant's failure to timely file a proper reply to the Office letter mailed on 18 October 2004. The Notice further indicates that no reply has been received.

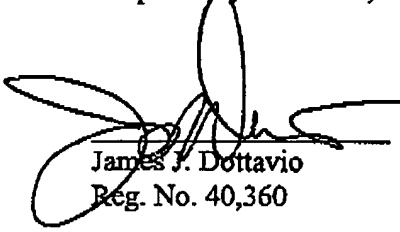
Applicant requests to provide documentation that a reply was submitted by Applicant to the 18 October 2004 letter. The 3-month deadline for responding to the letter was 18 January 2005. As shown in Exhibit B, a reply of 16 pages was transmitted by facsimile to the attention of Examiner Chapman on 14 January 2005. As shown in Exhibit C, the facsimile confirmation shows 16 pages was transmitted on 14 January 2005.

In view of the reply having been timely and completely transmitted by Applicant,  
Applicant requests that the holding of abandonment of the above application be withdrawn.

If any fees are required pertaining to this petition, it is respectfully requested that the fees  
be charged to Deposit Account No. 50-0568.

Please mail all correspondence to the attention of the Patent Administrator at the  
following address: Owens Corning, Patent Dept./Bldg. 11, 2790 Columbus Road, Granville,  
Ohio 43023.

Respectfully submitted,



James J. Dottavio  
Reg. No. 40,360

Date: 7-12-05

Owens Corning  
Patent Dept., Bldg. 11-7  
2790 Columbus Road  
Granville, Ohio 43023

(740) 321-7167

Jul. 13. 2005 9:06AM

No. 1766 P. 5

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,552	09/18/2003	Bert W. Elliott	25244A	4288
22889	7590	06/30/2005		
OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023			EXAMINER	
			CHAPMAN, JEANETTE E	
			ART UNIT	PAPER NUMBER
			3635	
DATE MAILED: 06/30/2005				

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Intellectual Property Law

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notice of Abandonment</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/664,552	ELLIOTT ET AL.
	Examiner	Art Unit
	Chapman E. Jeanette	3836

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address—

This application is abandoned in view of:

1.  Applicant's failure to timely file a proper reply to the Office letter mailed on 18 October 2004.
  - (a)  A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b)  A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c)  A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d)  No reply has been received.
  
2.  Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a)  The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b)  The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c)  The issue fee and publication fee, if applicable, has not been received.
  
3.  Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a)  Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b)  No corrected drawings have been received.
  
4.  The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
  
5.  The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
  
6.  The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
  
7.  The reason(s) below:



Jeanette Chapman  
Primary Exam'r

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

U.S. Patent and Trademark Office

Jul. 13. 2005 9:07AM

No. 1766 P. 7

OWENS CORNING SCIENCE & TECHNOLOGY CENTER  
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EXHIBIT B



## FAX TRANSMITTAL

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Date: January 14, 2005

JUL 13 2005

No. of Pages: 16 (Including this page)

To: Examiner Chapman

From: Jim Dottavio

Of: USPTO  
Art Unit 3635

Fax: (740) 321-8024

Fax: 703-872-9306

Phone: (740) 321-7167

SUBJECT: Amendment

Serial No.: U.S. Patent Application 10/664,552; filed September 18, 2003

I hereby certify that an Amendment for the above noted case is being transmitted to Examiner Chapman, at the U.S. Patent and Trademark Office (Fax No. (703) 872-9306) on January 14, 2005.

January 14, 2005

(Date of Deposit)

Brooke Spieth

(Name of Depositor)

*Brooke Spieth*

(Signature)

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 13 2005

Applicants: Bert W. Elliott GAU 3635; Conf. No. 4288  
Serial No.: 10/664,522 Examiner: Jeanette E. Chapman  
Filed: December 18, 2003 Attorney Docket No.: 25244A

For: LAMINATED STARTER SHINGLE FOR A ROOF COVERING

AMENDMENT

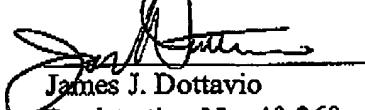
Mail Stop Amendment  
Commissioner for Patents, P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the office action mailed October 18, 2004, please amend the above-identified application as indicated on the following pages.

If any fees are required pertaining to this response, Applicant(s) request that all necessary fees be charged to Deposit Account No. 50-0568.

Respectfully submitted,

  
James J. Dottavio  
Registration No. 40,360

Date: 1-14-05

Law Dept./Attn. Docket Administrator  
Owens-Corning  
2790 Columbus Road, Building 11  
Granville, Ohio 43023  
(740) 321-7167

AMENDMENTS TO THE CLAIMS

Please amend the claims as indicated below.

1. (Original) A method of covering a roof deck, the method comprising:

laying a course of starter shingles in a side-by-side relationship at an eave edge of a roof deck, wherein a starter shingle of the course of starter shingles is a laminated starter shingle comprising an underlay sheet laminated below an overlay sheet; and

laying a plurality of successive generally horizontal courses of covering shingles above the course of starter shingles, the covering shingles in each of the courses of covering shingles being laid in a side-by-side relationship and horizontally offset from the covering shingles in adjacent courses, wherein each covering shingle of the courses of covering shingles includes a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, and wherein the starter shingles include an exposed portion extending between the tabs of the covering shingles.

2. (Original) The method according to Claim 1, wherein a difference between a height of the starter shingles and a height of the covering shingles is greater than about one inch.

3. (Original) The method according to Claim 1, wherein each covering shingle is a laminated covering shingle comprising:

an overlay member having a headlap portion and a butt portion; and  
an underlay member fixedly attached to a rear surface of the butt portion of the overlay member, the underlay member and the overlay member defining a laminated covering shingle, the butt portion including a plurality of tabs

separated by cutouts, the cutouts extending through the laminated covering shingle, wherein the exposed portion of the starter shingles extends between the tabs of the covering shingles.

4. (Original) The method according to Claim 3, wherein a difference between a height of the underlay sheet of each starter shingle and a height of the underlay member of each covering shingle is greater than about one inch.

5. (Currently amended) The method according to Claim 1, A method of covering a roof deck, the method comprising:

laying a course of starter shingles in a side-by-side relationship at an eave edge of a roof deck, wherein a starter shingle of the course of starter shingles is a laminated starter shingle comprising an underlay sheet laminated below an overlay sheet; and

laying a plurality of successive generally horizontal courses of covering shingles above the course of starter shingles, the covering shingles in each of the courses of covering shingles being laid in a side-by-side relationship and horizontally offset from the covering shingles in adjacent courses, wherein each covering shingle of the courses of covering shingles includes a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, and wherein the starter shingles include an exposed portion extending between the tabs of the covering shingles, wherein a height of the overlay sheet is greater than a height of the underlay sheet.

6. (Original) The method according to Claim 1, wherein the overlay sheet has a headlap portion and a butt portion, and wherein the underlay sheet is laminated beneath the butt portion of the overlay sheet.

7. (Original) The method according to Claim 6, wherein the butt portion includes a butt edge and the underlay sheet includes a lower edge, and wherein the butt edge and the lower edge are vertically aligned to define a lower edge of the starter shingle.

8. (Original) The method according to Claim 7, wherein a lower edge of the covering shingles in a first course of the covering shingles is vertically aligned with the lower edge of the starter shingles.

9. (Original) The method according to Claim 6, wherein the butt portions of the starter shingles have an overall color appearance that is substantially similar to an overall color appearance of the covering shingles.

10. (Original) The method according to Claim 1, further comprising applying a bead of adhesive to a bottom surface of the underlay sheet.

11. (Currently amended) A laminated starter shingle comprising:

a laminated starter shingle comprising an underlay sheet laminated below an overlay sheet, the sheet, said starter shingle used as part of a roof covering on a roof, the roof covering including comprising a plurality of successive generally horizontal courses of covering shingles laid above a plurality of the said starter shingles, the covering shingles in each of the courses of covering shingles being laid in a side-by-side relationship and vertically offset from the covering shingles in adjacent courses,

wherein each covering shingle of the courses of covering shingles includes a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, and

wherein the starter shingles include an exposed portion visible between the tabs of the covering shingles.

12. (Original) The laminated starter shingle according to Claim 11, wherein a difference between a height of the starter shingles and a height of the covering shingles is greater than about one inch.

13. (Currently amended) The laminated starter shingle according to Claim 11, A laminated starter shingle comprising an underlay sheet laminated below an overlay sheet, the starter shingle used as part of a roof covering on a roof, the roof covering including a plurality of successive generally horizontal courses of covering shingles laid above a plurality of the starter shingles, the covering shingles in each of the courses of covering shingles being laid in a side-by-side relationship and vertically offset from the covering shingles in adjacent courses

wherein each covering shingle of the courses of covering shingles includes a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts,

wherein the starter shingles include an exposed portion visible between the tabs of the covering shingles,

wherein each covering shingle is a laminated covering shingle comprising an overlay member having a headlap portion and a butt portion and an underlay member fixedly attached to a rear surface of the butt portion of the overlay member, and

wherein a difference between a height of the underlay sheet of each starter shingle and a height of the underlay member of each covering shingle is greater than about one inch.

14. (Currently amended) The laminated starter shingle according to Claim 11, A laminated starter shingle comprising an underlay sheet laminated below an overlay sheet, the starter shingle used as part of a roof covering on a roof, the roof covering including a plurality of successive generally horizontal courses of covering shingles laid above a plurality of the starter shingles, the covering shingles in each of the courses of covering shingles being laid in a side-by-side relationship and vertically offset from the covering shingles in adjacent courses, wherein each covering shingle of the courses of covering shingles includes a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts,

wherein the starter shingles include an exposed portion visible between the tabs of the covering shingles, and

wherein a height of the overlay sheet is greater than a height of the underlay sheet.

15. (Original) The laminated starter shingle according to Claim 11, wherein the overlay sheet has a headlap portion and a butt portion, and wherein the underlay sheet is laminated beneath the butt portion of the overlay sheet, and wherein the butt portion includes a butt edge and the underlay sheet includes a lower edge, and wherein the butt edge and the lower edge are vertically aligned to define a lower edge of the starter shingle, and wherein a lower edge of the covering shingles in a first course of the covering shingles is vertically aligned with the lower edge of the starter shingles.

16. (Original) The laminated starter shingle according to Claim 15, wherein the butt portions of the starter shingles have an overall color appearance that is substantially similar to an overall color appearance of the covering shingles.

17. (Original) The laminated starter shingle according to Claim 11 further comprising a bead of adhesive applied to a bottom surface of the underlay sheet.

18. (Original) A roof covering comprising:  
a course of starter shingles laid in a side-by-side relationship at an eave edge of a roof deck, wherein a starter shingle of the course of starter shingles is a laminated starter shingle comprising an underlay sheet laminated below an overlay sheet; and

a plurality of successive generally horizontal courses of covering shingles laid above the course of starter shingles, the covering shingles in each of the courses of covering shingles being laid in a side-by-side relationship and vertically offset from the covering shingles in adjacent courses,

wherein each covering shingle of the courses of covering shingles includes a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts, and

wherein the starter shingles include an exposed portion visible between the tabs of the covering shingles.

19. (Original) The roof covering according to Claim 18, wherein a difference between a height of the starter shingles and a height of the covering shingles is greater than about one inch.

20. (Original) The roof covering according to Claim 18, wherein each covering shingle is a laminated covering shingle comprising: an overlay member having a headlap portion and a butt portion; and an underlay member fixedly attached to a rear surface of the butt portion of the overlay member.

21. (Currently amended) ~~The roof covering according to Claim 20, A roof covering comprising:~~

a course of starter shingles laid in a side-by-side relationship at an eave edge of a roof deck, wherein a starter shingle of the course of starter shingles is a laminated starter shingle comprising an underlay sheet laminated below an overlay sheet; and

a plurality of successive generally horizontal courses of covering shingles laid above the course of starter shingles, the covering shingles in each of the courses of covering shingles being laid in a side-by-side relationship and vertically offset from the covering shingles in adjacent courses,

wherein each covering shingle of the courses of covering shingles includes a headlap portion and a butt portion, the butt portion including a plurality of tabs separated by cutouts,

wherein the starter shingles include an exposed portion visible between the tabs of the covering shingles,

wherein each covering shingle is a laminated covering shingle comprising:

an overlay member having a headlap portion and a butt portion; and an underlay member fixedly attached to a rear surface of the butt portion of the overlay member, and

wherein a difference between a height of the underlay sheet of each starter shingle and a height of the underlay member of each covering shingle is greater than about one inch.

22. (Original) The roof covering according to Claim 18, wherein a height of the overlay sheet is greater than a height of the underlay sheet.

23. (Original) The roof covering according to Claim 18, wherein the overlay sheet has a headlap portion and a butt portion, and wherein the underlay sheet is laminated beneath the butt portion of the overlay sheet.

24. (Original) The roof covering according to Claim 23, wherein the butt portion includes a butt edge and the underlay sheet includes a lower edge, and wherein the butt edge and the lower edge are vertically aligned to define a lower edge of the starter shingle.

25. (Original) The roof covering according to Claim 24, wherein a lower edge of the covering shingles in a first course of the covering shingles is vertically aligned with the lower edge of the starter shingles.

26. (Original) The roof covering according to Claim 23, wherein the butt portions of the starter shingles have an overall color appearance that is substantially similar to an overall color appearance of the covering shingles.

27. (Original) The roof covering according to Claim 18 further comprising a bead of adhesive applied to a bottom surface of the underlay sheet.

28. (New) The method according to Claim 5, wherein the overlay sheet has a headlap portion and a butt portion, and wherein the underlay sheet is laminated beneath the butt portion of the overlay sheet.

29. (New) The method according to Claim 28, wherein the butt portion includes a butt edge and the underlay sheet includes a lower edge, and wherein the butt edge and the lower edge are vertically aligned to define a lower edge of the starter shingle.

30. (New) The method according to Claim 29, wherein a lower edge of the covering shingles in a first course of the covering shingles is vertically aligned with the lower edge of the starter shingles.

31. (New) The method according to Claim 27, wherein the butt portions of the starter shingles have an overall color appearance that is substantially similar to an overall color appearance of the covering shingles.

32. (New) The laminated starter shingle according to Claim 13, wherein the underlay sheet is laminated beneath the butt portion of the overlay sheet, and wherein the butt portion includes a butt edge and the underlay sheet includes a lower edge, and wherein the butt edge and the lower edge are vertically aligned to define a lower edge of the starter shingle, and wherein a lower edge of the covering shingles in a first course of the covering shingles is vertically aligned with the lower edge of the starter shingles.

33. (New) The laminated starter shingle according to Claim 32, wherein the butt portions of the starter shingles have an overall color appearance that is substantially similar to an overall color appearance of the covering shingles.

34. (New) The laminated starter shingle according to Claim 14, wherein the underlay sheet is laminated beneath the butt portion of the overlay sheet, and wherein the butt portion includes a butt edge and the underlay sheet

includes a lower edge, and wherein the butt edge and the lower edge are vertically aligned to define a lower edge of the starter shingle, and wherein a lower edge of the covering shingles in a first course of the covering shingles is vertically aligned with the lower edge of the starter shingles.

35. (New) The laminated starter shingle according to Claim 34, wherein the butt portions of the starter shingles have an overall color appearance that is substantially similar to an overall color appearance of the covering shingles.

36. (New) The roof covering according to Claim 21, wherein the height of the overlay sheet is greater than the height of the underlay sheet.

37. (New) The roof covering according to Claim 21, wherein the underlay sheet is laminated beneath the butt portion of the overlay sheet.

38. (New) The roof covering according to Claim 37, wherein the butt portion includes a butt edge and the underlay sheet includes a lower edge, and wherein the butt edge and the lower edge are vertically aligned to define a lower edge of the starter shingle.

39. (New) The roof covering according to Claim 38, wherein a lower edge of the covering shingles in a first course of the covering shingles is vertically aligned with the lower edge of the starter shingles.

40. (New) The roof covering according to Claim 37, wherein the butt portions of the starter shingles have an overall color appearance that is substantially similar to an overall color appearance of the covering shingles.

REMARKS

Originally filed Claims 1 - 27 and newly filed Claims 28 - 40 are pending. Applicant requests reconsideration of the application in light of the following amendments and remarks.

In the outstanding office action, the Examiner objected to claims 5, 13, 14 and 21 as being dependent on a rejected base claim, but allowable if rewritten in independent form. As such, claims 5, 13, 14 and 21 have been amended and are now in condition for allowance. New claims 28 - 40 depend from the various allowable claims and present further patentable embodiments of the present invention.

Favorable reconsideration is respectfully requested in light of the following remarks. Applicants request withdrawal of the outstanding rejection and allowance of the claims.

Rejection under 35 U.S.C. §103(a)

In the outstanding office action, the Examiner rejected claims 1- 4, 6 - 12, 15 - 20 and 22 - 27 under 35 U.S.C. §103(a) over the Diamond U.S. Patent No. 4,148,168 (hereinafter, "Diamond") in view of the King et al. U.S. Patent No. 6,220,329 (hereinafter, "King et al.") references. Applicant contends that all the claims are patentable over these references, and requests withdrawal of the rejection under 35 U.S.C. §103.

It is respectfully submitted that the Office Action does not meet the criteria for establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. The mere fact that references can be

combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. Further, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP §2143.

The Examiner admits that the Diamond reference "lacks the starter shingle of the course of starter shingles." The Examiner also admits that the Diamond reference also "lacks the starter shingle including an exposed portion extending between tabs of the covering shingles."

With respect to the first criterion, there is no motivation to modify the Diamond reference with the covering shingle of the King et al. reference to meet the claimed invention. The King et al. describes multilayer covering shingles only.

There is no teaching or suggestion in the King et al. reference of any starter shingle or any suggestion to use of a row of starter shingles beneath the covering shingles. The figures 6, 7, 10b and 11b in the King et al. reference, relied upon by the Examiner, show a multiple layer covering shingle. The King et al. reference, at column 15, lines 48 - 67, describes a shingle 120 having a third, "bottom layer 126". Also, as clearly shown in the King et al. figures 6 and 7, the bottom layer 126 is part of a three-layer laminated shingle 120. Further, the King et al. reference, at column 16, lines 1 - 9 generally describes installing the shingles on a roof. There is no suggestion that two types of shingles are used in either the Diamond or King et al. references.

In contrast, the present invention provides a starter shingle useful for covering a roof deck by first laying a course of starter shingles and then laying sequential courses of covering shingles over the first course of starter shingles. As best seen in Fig. 5 of the instant application, the laminated starter shingle allows the subsequent layers of the covering shingles to be placed on the roof

without causing an undesirable bump in the roof as the covering layers are added onto the roof.

Also, neither the Diamond nor King et al. references addresses the installation issue solved by the present invention. The present inventive laminated starter shingle provides a roof installer with the ability to cover a roof deck without requiring the roof installer to expend undesirable time and effort in "fabricating" starter shingles at the job site. The King et al. reference teaches away from the present invention by showing only one type of multilayer covering shingle to be used on the entire roof.

Therefore, the independent Claims 1, 11 and 18, which describe two types of shingles (a laminated starter shingle and a covering shingle), are patentable over the Diamond reference, either alone or in combination with the King et al. reference. Since independent claims 1, 11 and 18 have been shown to be patentable over applied references, for at least for this reason, claims 2 - 4, 6 - 12, 15 - 16, 19 - 20, and 22 - 27 are also patentable over those references.

For at least for these reasons the cited reference fails to teach or suggest the invention defined in the claims. Accordingly, Applicants request withdrawal of the rejection under 35 U.S.C. §103.

#### Conclusion

None of the cited references teaches or suggests a laminated starter shingle having an underlay sheet laminated below an overlay sheet. Further, none of the cited references teaches or suggests covering a roof deck where a plurality of successive generally horizontal courses of covering shingles are laid above a plurality of laminated starter shingles. Rather, the cited references fail to suggest the present invention by failing to describe such features.

Claims 5, 13, 14 and 21 have been amended to be in independent form and are now in condition for allowance. The newly added claims 28 - 44 variously depend from the allowable claims and further describe features of the present invention.

In view of the above amendments and remarks, the Applicant has shown that the claims are in proper form for allowance, and the invention, as defined in the claims 1- 40, is neither disclosed nor suggested by the references of record. Accordingly, the Applicant respectfully requests allowance of all claims.

Jul. 13. 2005 9:12AM

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EXHIBIT C

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## FAX TRANSMITTAL

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To: Examiner Chapman From: Jim Dottavio

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Art Unit 3635

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SUBJECT: Amendment

Serial No.: U.S. Patent Application 10/664,552; filed September 18, 2003

I hereby certify that an Amendment for the above noted case is being transmitted to Examiner Chapman, at the U.S. Patent and Trademark Office (Fax No. (703) 872-9306) on January 14, 2005.

January 14, 2005  
(Date of Deposit)

Brooke Spieth  
(Name of Depositor)

*Brooke Spieth*  
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